



## UNITED STATES DEPARTMENT OF COMMERCE

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/485,129 06/07/95 WALLACH

D WALLACH=5B

EXAMINER

SCHWADRON, R

ART UNIT PAPER NUMBER

7

18M1/0905

BROWDY AND NEIMARK  
419 SEVENTH STREET N W  
WASHINGTON DC 20004

1816

DATE MAILED:

09/05/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

restricted

 This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.A shortened statutory period for response to this action is set to expire 1 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

## Part II SUMMARY OF ACTION

1.  Claims 11-14, 33-45 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2.  Claims \_\_\_\_\_ have been cancelled.
3.  Claims \_\_\_\_\_ are allowed.
4.  Claims \_\_\_\_\_ are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  Claims 11-14, 33-45 are subject to restriction or election requirement.
7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8.  Formal drawings are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).
11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).
12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other

## EXAMINER'S ACTION

15. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 11-13, 33-38, 40, 41, 43, 44 are drawn to DNA, expression vectors containing said DNA, and host cells containing said expression vectors, classified in Class 435, subclasses 320.1, 240.2 and 252.3, and Class 536, subclass 23.5.

II. Claims 14, 39, 42 and 45 are drawn to a process for producing a protein, classified in Class 435, subclass 69.1.

16. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as preparation of DNA probes that can be used in hybridization assays to detect TBP-II DNA in cells.

17. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and Groups I and II have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

18. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

20. Papers related to this application may be submitted to Group 180 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers should be faxed to Group 180 at (703) 305-7939.

21. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Tuesday through Friday from 8:30 to 6:00. The examiner can also be reached on alternative Mondays. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ms Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 180 receptionist whose telephone number is (703) 308-0196.

*Ron Schwadron*

**RONALD B. SCHWADRON  
PRIMARY EXAMINER  
GROUP 1800**

Ron Schwadron, Ph.D.  
Primary Examiner  
Art Unit 1816  
September 3, 1996